

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2002 (Substitute form) <i>Patent fees are subject to annual revision.</i>		Complete if Known	
Application Number: 09/525,041 Filing Date: Soppet, et al. First Named Inventor: March 14, 2000 Examiner Name: Holleran, A. Group Art Unit: 1642 Attorney Docket Number: PF178D2		Application Number: 09/525,041 Filing Date: Soppet, et al. First Named Inventor: March 14, 2000 Examiner Name: Holleran, A. Group Art Unit: 1642 Attorney Docket Number: PF178D2	
Total amount of payment: \$0.00		Application Number: 09/525,041 Filing Date: Soppet, et al. First Named Inventor: March 14, 2000 Examiner Name: Holleran, A. Group Art Unit: 1642 Attorney Docket Number: PF178D2	

METHOD OF PAYMENT	FEE CALCULATION (continued)																																																																																																																																																																																																						
1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to: Deposit Account Number: 08-3425 Deposit Account Name: Human Genome Sciences, Inc. <input checked="" type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17 <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27 2. <input type="checkbox"/> Payment Enclosed: <input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> Other*	3. ADDITIONAL FEES <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Fee Code</th> <th>Large Entity Fee (\$)</th> <th>Fee Code</th> <th>Small Entity Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>105</td><td>130</td><td>205</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>127</td><td>50</td><td>227</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr> <tr><td>139</td><td>130</td><td>139</td><td>130</td><td>Non-English specification</td><td></td></tr> <tr><td>142</td><td>1,280</td><td>242</td><td>640</td><td>Utility issue fee (or reissue)</td><td></td></tr> <tr><td>195</td><td>300</td><td>195</td><td>300</td><td>Publication fee for early, voluntary, or normal publication</td><td></td></tr> <tr><td>179</td><td>740</td><td>279</td><td>370</td><td>Request for Continued Examination (RCE)</td><td></td></tr> <tr><td>098</td><td>130</td><td>098</td><td>130</td><td>Processing fee, except in provisional applications</td><td></td></tr> <tr><td>126</td><td>180</td><td>126</td><td>180</td><td>Submission of Information Disclosure Statement</td><td></td></tr> <tr><td>123</td><td>50</td><td>123</td><td>50</td><td>Processing fee for provisional applications</td><td></td></tr> <tr><td>146</td><td>740</td><td>246</td><td>370</td><td>Filing a submission after final rejection (37 CFR 1.129(a))</td><td></td></tr> <tr><td>149</td><td>740</td><td>249</td><td>370</td><td>For each additional invention to be examined (37 CFR 1.129(b))</td><td></td></tr> <tr><td>145</td><td>100</td><td>145</td><td>100</td><td>Certificate of correction</td><td></td></tr> <tr><td>147</td><td>2,520</td><td>147</td><td>2,520</td><td>Request for <i>ex parte</i> reexamination</td><td></td></tr> <tr><td>099</td><td>8,800</td><td>099</td><td>8,800</td><td>Request for <i>inter partes</i> reexamination</td><td></td></tr> <tr><td>148</td><td>110</td><td>248</td><td>55</td><td>Statutory disclaimer</td><td></td></tr> <tr><td>115</td><td>110</td><td>215</td><td>55</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>116</td><td>400</td><td>216</td><td>200</td><td>Extension for reply within second month</td><td></td></tr> <tr><td>117</td><td>920</td><td>217</td><td>460</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>118</td><td>1,440</td><td>218</td><td>720</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>128</td><td>1,960</td><td>228</td><td>980</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>119</td><td>320</td><td>219</td><td>160</td><td>Notice of appeal</td><td></td></tr> <tr><td>120</td><td>320</td><td>220</td><td>160</td><td>Filing a brief in support of an appeal</td><td></td></tr> <tr><td>121</td><td>280</td><td>221</td><td>140</td><td>Request for oral hearing</td><td></td></tr> <tr><td>122</td><td>130</td><td>122</td><td>130</td><td>Petitions to the Commissioner</td><td></td></tr> <tr><td>140</td><td>110</td><td>240</td><td>55</td><td>Petition to revive unavoidably abandoned application</td><td></td></tr> <tr><td>141</td><td>1,280</td><td>241</td><td>640</td><td>Petition to revive unintentionally abandoned application</td><td></td></tr> <tr><td>091</td><td>1,280</td><td>091</td><td>1,280</td><td>Acceptance of an unintentionally delayed claim for priority</td><td></td></tr> <tr><td>561</td><td>3</td><td>561</td><td>3</td><td>Printed copy of patent, regular service</td><td></td></tr> <tr><td>581</td><td>40</td><td>481</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td></td></tr> <tr><td colspan="5">Other fee (specify):</td><td></td></tr> <tr><td colspan="5">Other fee (specify):</td><td></td></tr> <tr><td colspan="5">Other fee (specify):</td><td></td></tr> </tbody> </table>	Fee Code	Large Entity Fee (\$)	Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid	105	130	205	65	Surcharge - late filing fee or oath		127	50	227	25	Surcharge - late provisional filing fee or cover sheet		139	130	139	130	Non-English specification		142	1,280	242	640	Utility issue fee (or reissue)		195	300	195	300	Publication fee for early, voluntary, or normal publication		179	740	279	370	Request for Continued Examination (RCE)		098	130	098	130	Processing fee, except in provisional applications		126	180	126	180	Submission of Information Disclosure Statement		123	50	123	50	Processing fee for provisional applications		146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))		149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))		145	100	145	100	Certificate of correction		147	2,520	147	2,520	Request for <i>ex parte</i> reexamination		099	8,800	099	8,800	Request for <i>inter partes</i> reexamination		148	110	248	55	Statutory disclaimer		115	110	215	55	Extension for reply within first month		116	400	216	200	Extension for reply within second month		117	920	217	460	Extension for reply within third month		118	1,440	218	720	Extension for reply within fourth month		128	1,960	228	980	Extension for reply within fifth month		119	320	219	160	Notice of appeal		120	320	220	160	Filing a brief in support of an appeal		121	280	221	140	Request for oral hearing		122	130	122	130	Petitions to the Commissioner		140	110	240	55	Petition to revive unavoidably abandoned application		141	1,280	241	640	Petition to revive unintentionally abandoned application		091	1,280	091	1,280	Acceptance of an unintentionally delayed claim for priority		561	3	561	3	Printed copy of patent, regular service		581	40	481	40	Recording each patent assignment per property (times number of properties)		Other fee (specify):						Other fee (specify):						Other fee (specify):					
Fee Code	Large Entity Fee (\$)	Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid																																																																																																																																																																																																		
105	130	205	65	Surcharge - late filing fee or oath																																																																																																																																																																																																			
127	50	227	25	Surcharge - late provisional filing fee or cover sheet																																																																																																																																																																																																			
139	130	139	130	Non-English specification																																																																																																																																																																																																			
142	1,280	242	640	Utility issue fee (or reissue)																																																																																																																																																																																																			
195	300	195	300	Publication fee for early, voluntary, or normal publication																																																																																																																																																																																																			
179	740	279	370	Request for Continued Examination (RCE)																																																																																																																																																																																																			
098	130	098	130	Processing fee, except in provisional applications																																																																																																																																																																																																			
126	180	126	180	Submission of Information Disclosure Statement																																																																																																																																																																																																			
123	50	123	50	Processing fee for provisional applications																																																																																																																																																																																																			
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))																																																																																																																																																																																																			
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))																																																																																																																																																																																																			
145	100	145	100	Certificate of correction																																																																																																																																																																																																			
147	2,520	147	2,520	Request for <i>ex parte</i> reexamination																																																																																																																																																																																																			
099	8,800	099	8,800	Request for <i>inter partes</i> reexamination																																																																																																																																																																																																			
148	110	248	55	Statutory disclaimer																																																																																																																																																																																																			
115	110	215	55	Extension for reply within first month																																																																																																																																																																																																			
116	400	216	200	Extension for reply within second month																																																																																																																																																																																																			
117	920	217	460	Extension for reply within third month																																																																																																																																																																																																			
118	1,440	218	720	Extension for reply within fourth month																																																																																																																																																																																																			
128	1,960	228	980	Extension for reply within fifth month																																																																																																																																																																																																			
119	320	219	160	Notice of appeal																																																																																																																																																																																																			
120	320	220	160	Filing a brief in support of an appeal																																																																																																																																																																																																			
121	280	221	140	Request for oral hearing																																																																																																																																																																																																			
122	130	122	130	Petitions to the Commissioner																																																																																																																																																																																																			
140	110	240	55	Petition to revive unavoidably abandoned application																																																																																																																																																																																																			
141	1,280	241	640	Petition to revive unintentionally abandoned application																																																																																																																																																																																																			
091	1,280	091	1,280	Acceptance of an unintentionally delayed claim for priority																																																																																																																																																																																																			
561	3	561	3	Printed copy of patent, regular service																																																																																																																																																																																																			
581	40	481	40	Recording each patent assignment per property (times number of properties)																																																																																																																																																																																																			
Other fee (specify):																																																																																																																																																																																																							
Other fee (specify):																																																																																																																																																																																																							
Other fee (specify):																																																																																																																																																																																																							
1. BASIC FILING FEE <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Entity</th> <th>Small Entity</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>101</td><td>740</td><td>201</td><td>370</td><td>Utility filing fee</td><td></td></tr> <tr><td>106</td><td>330</td><td>206</td><td>165</td><td>Design filing fee</td><td></td></tr> <tr><td>107</td><td>510</td><td>207</td><td>255</td><td>Plant filing fee</td><td></td></tr> <tr><td>108</td><td>740</td><td>208</td><td>370</td><td>Reissue filing fee</td><td></td></tr> <tr><td>114</td><td>160</td><td>214</td><td>80</td><td>Provisional filing fee</td><td></td></tr> <tr><td colspan="4" style="text-align: right;">SUBTOTAL (1)</td><td>\$0.00</td></tr> </tbody> </table> 2. EXTRA CLAIM FEES <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Total Claims</th> <th>Extra Claims</th> <th>Fee from below</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>Independent Claims</td><td>-20*</td><td>\$18.00</td><td></td></tr> <tr><td>Multiple Dependent</td><td>-3*</td><td>\$84.00</td><td></td></tr> <tr><td colspan="3"></td><td>\$280.00</td></tr> </tbody> </table> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Entity Fee Code</th> <th>Large Entity Fee (\$)</th> <th>Small Entity Fee Code</th> <th>Small Entity Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>103</td><td>18</td><td>203</td><td>9</td><td>Claims in excess of 20</td><td></td></tr> <tr><td>102</td><td>84</td><td>202</td><td>42</td><td>Independent claims in excess of 3</td><td></td></tr> <tr><td>104</td><td>280</td><td>204</td><td>140</td><td>Multiple dependent claim, if not paid</td><td></td></tr> <tr><td>108</td><td>84</td><td>209</td><td>42</td><td>Reissue independent claims over original patent</td><td></td></tr> <tr><td>110</td><td>18</td><td>210</td><td>9</td><td>Reissue claims in excess of 20 and over original patent</td><td></td></tr> <tr><td colspan="5" style="text-align: right;">SUBTOTAL (2)</td><td>\$0.00</td></tr> </tbody> </table>	Large Entity	Small Entity	Fee Description	Fee Paid	101	740	201	370	Utility filing fee		106	330	206	165	Design filing fee		107	510	207	255	Plant filing fee		108	740	208	370	Reissue filing fee		114	160	214	80	Provisional filing fee		SUBTOTAL (1)				\$0.00	Total Claims	Extra Claims	Fee from below	Fee Paid	Independent Claims	-20*	\$18.00		Multiple Dependent	-3*	\$84.00					\$280.00	Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid	103	18	203	9	Claims in excess of 20		102	84	202	42	Independent claims in excess of 3		104	280	204	140	Multiple dependent claim, if not paid		108	84	209	42	Reissue independent claims over original patent		110	18	210	9	Reissue claims in excess of 20 and over original patent		SUBTOTAL (2)					\$0.00	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 80%;"> * or number previously paid, if greater; For Reissues, see above </td> <td style="width: 20%; text-align: right;"> SUBTOTAL (3) </td> </tr> <tr> <td style="text-align: right;">Reduced by Basic Filing Fee Paid</td> <td style="text-align: right;">\$0.00</td> </tr> </table>	* or number previously paid, if greater; For Reissues, see above	SUBTOTAL (3)	Reduced by Basic Filing Fee Paid	\$0.00																																																																																																	
Large Entity	Small Entity	Fee Description	Fee Paid																																																																																																																																																																																																				
101	740	201	370	Utility filing fee																																																																																																																																																																																																			
106	330	206	165	Design filing fee																																																																																																																																																																																																			
107	510	207	255	Plant filing fee																																																																																																																																																																																																			
108	740	208	370	Reissue filing fee																																																																																																																																																																																																			
114	160	214	80	Provisional filing fee																																																																																																																																																																																																			
SUBTOTAL (1)				\$0.00																																																																																																																																																																																																			
Total Claims	Extra Claims	Fee from below	Fee Paid																																																																																																																																																																																																				
Independent Claims	-20*	\$18.00																																																																																																																																																																																																					
Multiple Dependent	-3*	\$84.00																																																																																																																																																																																																					
			\$280.00																																																																																																																																																																																																				
Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid																																																																																																																																																																																																		
103	18	203	9	Claims in excess of 20																																																																																																																																																																																																			
102	84	202	42	Independent claims in excess of 3																																																																																																																																																																																																			
104	280	204	140	Multiple dependent claim, if not paid																																																																																																																																																																																																			
108	84	209	42	Reissue independent claims over original patent																																																																																																																																																																																																			
110	18	210	9	Reissue claims in excess of 20 and over original patent																																																																																																																																																																																																			
SUBTOTAL (2)					\$0.00																																																																																																																																																																																																		
* or number previously paid, if greater; For Reissues, see above	SUBTOTAL (3)																																																																																																																																																																																																						
Reduced by Basic Filing Fee Paid	\$0.00																																																																																																																																																																																																						

Submitted By		Complete (if applicable)	
Name (Print/Type): Jonathan L. Klein	Registration No.: 41,119	Telephone: 301-251-6015	
Signature:		Date: 12/3/01	

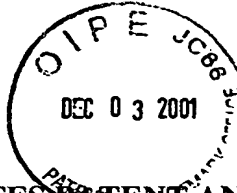
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

RECEIVED

DEC - 5 2001

TECH CENTER 1600/2900



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Soppet, et al.**

Application No.: **09/525,041**

Art Unit: **1642**

Filed: **March 14, 2000**

Examiner: **Holleran, A.**

For: **Colon Specific Gene and Protein** Atty Docket No.: **PF178D2**

#

11

120

1-701

PROVISIONAL ELECTION WITH TRAVERSE
UNDER 37 C.F.R. § 1.143

Commissioner of Patents
Washington, D.C. 20231

Dear Sir or Madam:

In response to the Office Action mailed November 6, 2001 please consider the following provisional election with traverse. Applicants submit concurrently herewith a Fee Transmittal Sheet.

Provisional Election and Traverse

The Examiner has required restriction of the claimed subject matter into one of two different groups.

In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group I (claims 21-37, 46-63, 72-89, 98-115, and 124). Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Additionally, should the present restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants note that the Examiner has required restriction based on an assertion that the "product as claimed can be used in a materially different process of using that product." *See*, Paper No. 10, page 2, last paragraph. In particular, the Examiner asserted "the antibodies of Group I may be used in *in vivo* methods of treatment." And further, "[a]n *in vivo* method of treatment is a materially different method than the *in vitro* method of detection of an antigen." *See*, Paper No. 10, page 2, last sentence to page 3, first full sentence.

Applicants respectfully traverse.

As a threshold matter, the possibility of an alternative use alone is not sufficient to impose a restriction requirement. Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Although the Examiner has indicated that Groups I and II are separately classified, Applicants submit that a search of the composition claims of Group I would largely overlap (and therefore provide useful information for) a search for the method claims of Group II. For example, a search for publications drawn to antibodies of the present invention would largely overlap with a search directed toward methods of detecting the protein to which said antibodies bind.

Thus, the search and examination of the composition and method claims would not entail a serious burden. Accordingly, in view of the above traverse, Applicants respectfully request that the Restriction Requirement be withdrawn so the subject matter of all the groups can be examined together.

Should the restriction requirement not be withdrawn, in order to expedite prosecution of this case, Applicants provisionally elect, *with traverse*, the subject matter of Group I represented by claims 21-37, 46-63, 72-89, 98-115, and 124.

Furthermore, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Group I and II once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

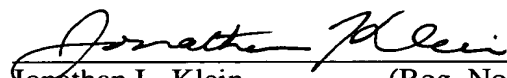
Id. Accordingly, if claims of Group I are found allowable, Applicants respectfully request that the claims of Group II be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

CONCLUSION

Applicants respectfully request that the remarks above be entered and made of record in the file history of the instant application.

Respectfully submitted,

Date: DECEMBER 3, 2001


Jonathan L. Klein (Reg. No. 41,119)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Phone 301-251-6015

JKE/DAS/kp